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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/618,794 07/18/00 CAWSE

J RD-26357

006147 HM22/1208  
GENERAL ELECTRIC COMPANY  
CRD PATENT DOCKET ROOM 4A59  
P O BOX 8  
BUILDING K 1 SALAMONE  
SCHENECTADY NY 12301

EXAMINER

PRASTHOFFER, T

ART UNIT

PAPER NUMBER

1627

DATE MAILED:

12/08/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/618,794

Applicant(s)

CAWSE, JAMES NORMAN

Examiner

Thomas Prasthofer

Art Unit

1627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 18 July 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 1-25 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_.

***Detailed Action***

***Restriction***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-15, drawn to a high-throughput screening method, classified in class 435, subclass 7.1.
  - II. Claims 16-25, drawn to combinatorial chemical synthesis systems, classified in class 422, subclass 13.1.
2. The inventions are distinct, each from the other because:
3. Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the process of Invention I can be practiced manually without apparatus. Furthermore, the apparatus can be used for both combinatorial organic synthesis and for screening preexisting combinatorial chemical libraries. Art anticipating or rendering obvious Invention I would not anticipate or render obvious Invention II. Each invention would support a separate patent.
4. Because these inventions are distinct for the reasons given above and
  - a. have acquired a separate status in the art as shown by their different classification ;

- b. have different and separately burdensome: manual and/or computer: structure, name and bibliographical searches; and
  - c. have divergent subject matter, restriction for examination purposes as indicated is proper.
5. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).
6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently filed petition under 37 CFR 1.48(b) and by the fee required under CFR 1.17(h).

### ***Election of Species***

7. This application contains claims directed to patentably distinct species of the claimed invention. If applicant elects Invention I, applicant is required to elect from the following patentably distinct species.

Species of combination of reactants: claims 1-6, 8, 10, 11

Species of reaction parameter: claims 3, 7

Species of liquid: claim 10

Species of gas: claim 10

Species of group VIII B metal: claim 11

Species of halide composition: claim 13

Species of inorganic co-catalyst: claim 14

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The species are distinct, each from the other, because their compositions, reaction and processing conditions, products, and methods of detection are different. Therefor, different issues of enablement and patentability apply to each species and each species represents patentably distinct subject matter.

8. This application contains claims directed to patentably distinct species of the claimed invention. If applicant elects Invention II, applicant is required to elect from the following patentably distinct species.

Species of combination of reactants: claims 16, 20, 23, 25

Species of controller: claims 22-25

Species of reaction parameter: claims 22, 25

Species of detector: claim 24

The species are distinct, each from the other, because their compositions, reaction and processing conditions, products, and methods of detection are different. Therefor, different issues of enablement and patentability apply to each species and each species represents patentably distinct subject matter.

9. Applicant is required under U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally to be allowable.

10. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after election, applicant must indicate which are readable upon the elected species.


11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Thomas W. Prasthofer** whose telephone number is (703) 308-4548. The examiner can normally be reached on Monday-Friday, 8:00-4:30.

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12. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jyothsna Venkat can be reached on (703) 308-2439. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-2742 for regular communications and (703) 308-7921 for After Final communications.

13. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Thomas Prasthofer  
11/14/00

  
**DR. JYOTHSNA VENKAT PH.D**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 1600**